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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,957	10/18/2000	Samuel Benjamin Schaeviz	ACBI.049.00US	5382

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ACLARA BIOSCIENCES, INC.
1288 PEAR AVENUE
MOUNTAIN VIEW, CA 94043

EXAMINER

SINES, BRIAN J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/691,957	Applicant(s) SCHAEVITZ ET AL.	
	Examiner Brian J. Sines	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,6,8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 5 is/are rejected.
- 7) ☒ Claim(s) 2,6,8,10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

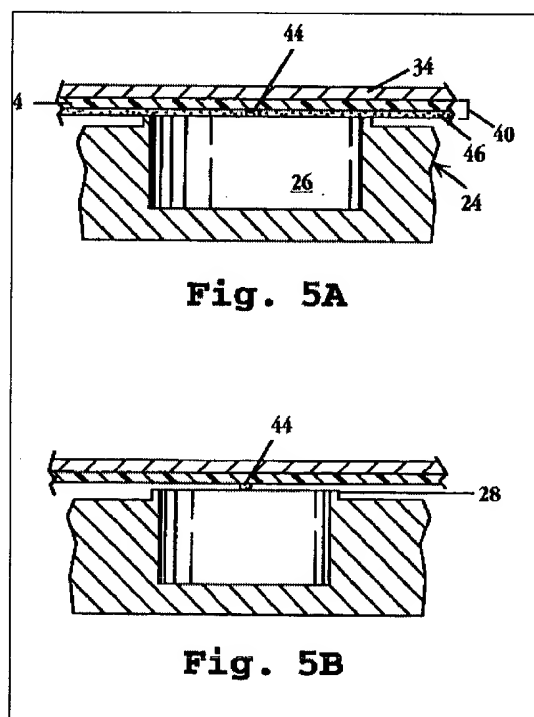
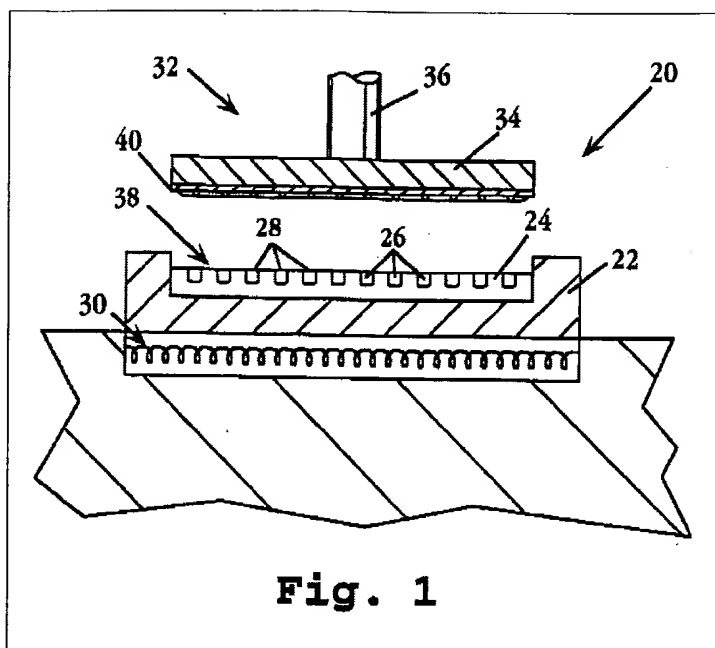
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

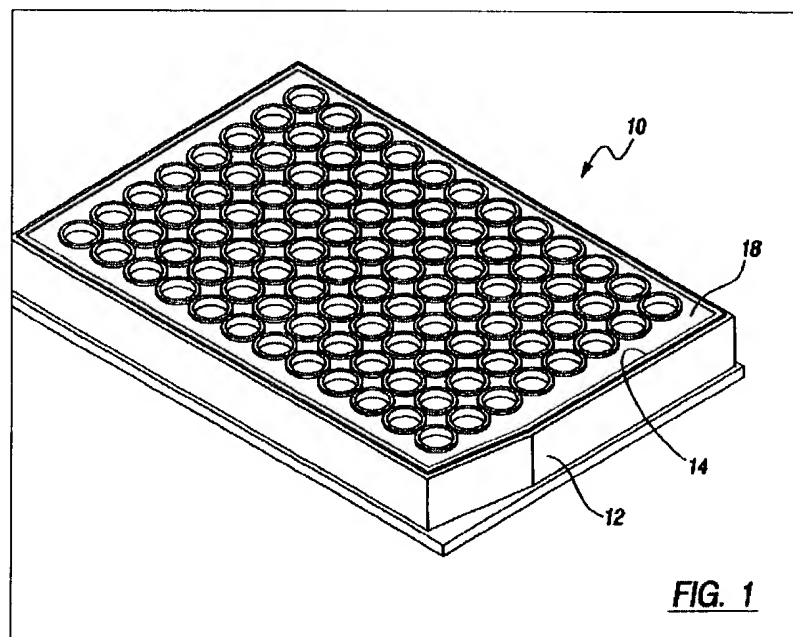
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

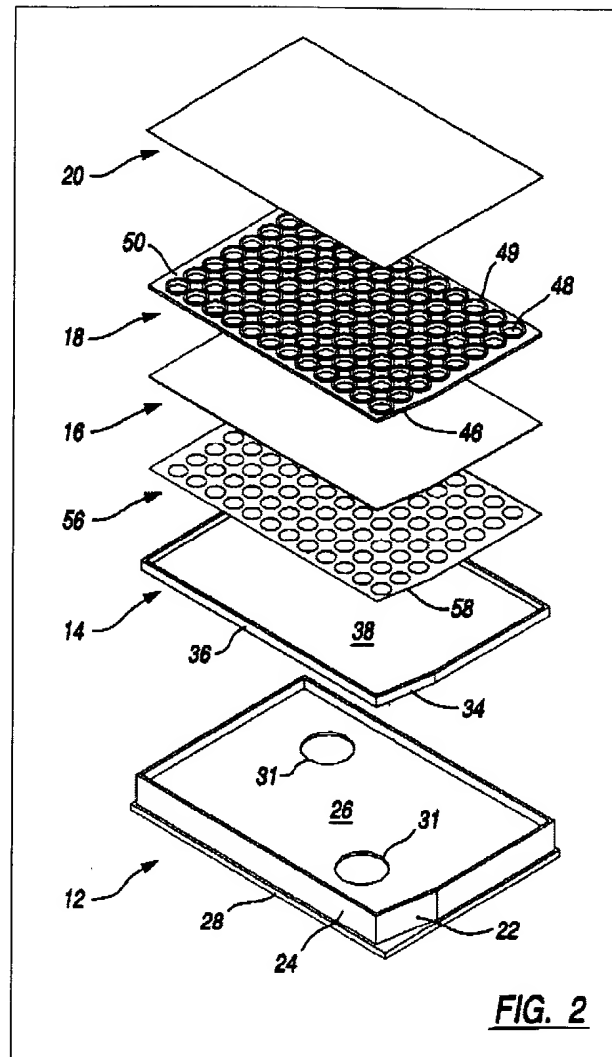
1. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Warner et al. (U.S. Pat. No. 5,604,130 A). Warner et al. teach an apparatus (20) comprising: a substrate (multiwell plate 24) comprising a planar surface and at least one microfluidic unit formed therein, wherein each microfluidic unit comprises at least one reservoir (well 26) with an opening in the surface, such that the opening is surrounded by a collar in relief (ridges located at 28; figure 5B), wherein the collar is covered with a lid structure (cover 34 & pad 40; figure 5A) composed of a deformable material (see col. 1, line 65 – col. 2, line 51; col. 3, line 21 – col. 6, line 59; figures 1, 5A & 5B).



2. Claims 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolb et al. (U.S. Pat. No. 5,961,926 A). Regarding claim 3, Kolb et al. teach an apparatus (microplate assembly 10) comprising: a substrate (collimator 18) comprising a planar

surface and at least one microfluidic unit formed therein, wherein each microfluidic unit comprises at least one reservoir (well 48) with an opening in the surface, such that the opening is surrounded by a collar in relief (upper rim 49), wherein the collar is covered with a lid structure (cover film 20) composed of a deformable material (see col. 3, line 25 – col. 6, line 54; figures 1 & 2). Regarding claim 5, Kolb et al. teach that the apparatus is made of a plastic material (see, e.g., col. 3, lines 59 – 63; col. 5, lines 21 – 24). In claim 5, regarding the recitation that the apparatus is “produced by plastic molding,” the determination of patentability is based upon the apparatus structure itself. The patentability of a product or apparatus does not depend on its method of production or formation. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP § 2113).





Response to Arguments

Applicant's arguments with respect to claims 2, 3, 5, 6, 8, 10 and 11 have been considered, but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 2, 6, 8, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1743

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 2, the cited prior art neither teach nor fairly suggest the further incorporation within either the apparatus of Kolb et al. or Warner et al. a collar having a thickness of from about 0.05 to 0.5 mm thick extending away from the inner surface of the opening.

Regarding claim 6, the cited prior art neither teach nor fairly suggest the further incorporation within either the apparatus of Kolb et al. or Warner et al. a microfluidic unit comprising one or more operational units each comprising at least two reservoirs connected by at least one microchannel in the substrate, wherein each of the reservoirs has an opening in the planar surface and a volume in the range of about 10 nL to 10 μ L; and wherein each opening has an inner surface aligned with an inner surface of the reservoir and the collar having a height in the range of about 0.1 to 1 mm and a thickness of from about 0.05 to 0.5 mm thick extending away from the inner surface.

Conclusion

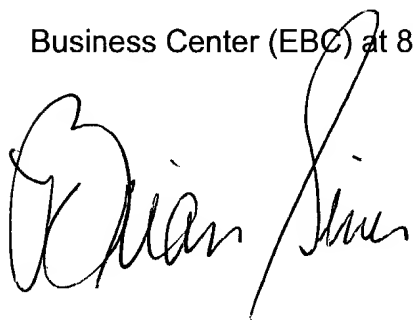
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Fernwood et al. teach a filtration plate assembly. Freeman teaches an assay and culture tray. Thorne teaches microtest plates. Lyman et al. teach a multiwell test plate. Andrews et al. teach an analytical apparatus using sealed microwell arrays. Sanadi teaches a method and apparatus for preventing the cross-contamination of multiwell test plates. Boulton et al. teach a method and apparatus for sealing a microplate assembly.

Art Unit: 1743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Brian J. Sines". The signature is fluid and cursive, with the first name "Brian" being more prominent than the last name "Sines".